



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/287,023 04/06/99 MALIK

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EXAMINER

NGUYEN, D

ART UNIT

PAPER NUMBER

2643

DATE MAILED:

10/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/287,023

Applicant(s)

MALIK

Examiner

Duc M Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 17, 10-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1-6, 10-13, 15-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Nikander (6,029,151).

Consider claims 1-3, 10, 12-13, 18-21, 26-29, 34. Nikander teaches a method for using a communication to conduct a transaction (e.g., transferring fund between user and merchant; see the abstract) with respect to a telecommunications account (see the abstract; col. 2, ln. 55-67; col. 4, ln. 14-41; ln. 46-52), comprising the calling line is met by the caller's telephone number (telephone account; col. 2, ln. 46-52); the transaction amount is met by (col. 2, ln. 55-67); the billing system is met by the control unit 122 (col. 4, ln. 14-52). All other limitations of claim 1 are met by Nikander teachings (col. 5, ln. 61 to col. 6, ln. 16; col. 6, ln. 31-65; col. 10, ln. 22-40; col. 13, ln. 58 to col. 14, ln. 67).

Consider claims 4-6, 11, 15-17. Nikander further teaches the validation step in claims 4-6, 11, 15-17 (authentication software 122f; col. 13, ln. 58 to col. 14, ln. 67).

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Consider claims 22-25, 30-33. Nikander further teaches that the transfer is reflected as a debit on the user's phone bill (col. 5, ln. 61 to col. 6, ln. 65).

Consider claim 35. Nikander teach a method for executing a transaction, comprising receiving a communication associated with a calling line number (col. 4, ln. 14-52); obtaining a transaction amount from the communication (col. 4, ln. 14-52; col. 5, ln. 61 to col. 6, ln. 65); coding the transaction amount and the calling line number into a billing message (col. 4, ln. 14-52); posting the billing message (col. 4, ln. 14-52; col. 5, ln. 61 to col. 6, ln. 65; col. 12, ln. 62 to col. 14, ln. 53); obtaining the billing message, and decoding the transaction amount and the calling line number from the billing message (col. 4, ln. 14-52; col. 5, ln. 61 to col. 6, ln. 65; col. 12, ln. 62 to col. 14, ln. 53); and crediting or debiting an account associated with the calling line number by the transaction amount (col. 4, ln. 14-52; col. 5, ln. 61 to col. 6, ln. 65; col. 12, ln. 62 to col. 14, ln. 53).

Consider claims 36-37. Nikander teaches a system for allowing a user to initiate a transaction and have the transaction conducted, comprising a SSP (fig. 3); a SCP (col. 12, ln. 62 to col. 14, ln. 53); and a billing system (col. 5, ln. 61 to col. 6, ln. 65).

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made..

4. Claims 7, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nikander (6,029,151).

Consider claims 7, 14. Nikander further teaches the billing system confirms completion of the transaction by generating and displaying a transaction confirmation/authorization number code (col. 6, ln. 57-67) which reads on the limitations of claims 7, 14, except for the step of providing an announcement to the communication. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to announce a transaction confirmation/authorization without changing the scope of the claimed subject matter which is to provide the user with confirmation message so that the user knows for sure that the transaction went smoothly and completely.

#### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Nguyen whose telephone number is (703) 308-7527.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Kuntz, can be reached on (703) 305-4708.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

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**or faxed to:**

**(703) 308-6306 or (703) 308-6296** (Group's Fax numbers)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

October 16, 2001

  
**DUC NGUYEN**  
**PRIMARY EXAMINER**